

## **REMARKS**

Based on the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has rejected claims 1-3, 10, 13 and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,842,920 (Barnetche-Gonzalez). Applicants respectfully disagree with this rejection.

Barnetche-Gonzalez only discloses a drill consisting of a striking part and a cutting part but these parts never overlap each other upon rotation. Such a structure is an essential feature of the invention (p. 3, l.10-19). One and the same position at the ground of the drill hole, only through this feature, is worked alternately by the striking part and the cutting part.

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since Barnetche-Gonzalez fails to disclose each and every feature of independent claim 1, Barnetche-Gonzalez, as a matter of law, does not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that Barnetche-Gonzalez does not anticipate or make obvious the present invention as defined in claim 1, and the present invention is patentable over such references. Claims 2-3, 10, 13 and 15 depend on claim 1 and are allowable for the same reasons claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 1 are not disclosed or suggested in the prior art.

The Examiner has rejected claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Barnetche-Gonzalez in view of U.S. Patent No. 3,259,403 (Hjalsten). Applicants respectfully disagree with these rejections.

In addition to the arguments raised above with respect to the 35 USC 102 rejection of the claims, Applicants respectfully submit that Hjalsten also fails to disclose or teach a striking part and a cutting part that overlap each other upon rotation.

*A prima facie* case of obviousness has not been met by the Examiner.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or

suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983): SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a prima facie case of obviousness. MPEP §2143.01 relying on Ex Parte Levensgood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

*Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

*In re Fritch*, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own

statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that the teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” In *re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in claims 11 and 12, obvious, and the present invention is patentable over such references.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



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